

REMARKS/ARGUMENTS

Claims 1-21 are pending in the application. The abstract stands objected to. Claims 1-2 and 4 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,231,569 to Myatt et al. Claims 3, and 5-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Myatt et al., as applied in the 102(b) rejection, and further in view of U.S. Patent No. 6,990,471 to Rajaram.

In regards to the objections to the abstract, Applicants do not agree that the terminology “is provided” is in any way identified as being objectionable by MPEP 608.01(b), and the Examiner is the first to ever object to that terminology, which has been used in abstracts by counsel for the Applicants in well over one hundred applications that have been allowed and issued as U.S. patents. Applicants do not oppose an Examiner’s amendment to delete those words, if such is deemed necessary by the Examiner, as they only provide grammatical clarity to the abstract and do not provide any substance, but do not agree that any changes are necessary.

In regards to the rejection of claims 1-2 and 4 under 35 U.S.C. 102(b) as being anticipated by Myatt, Myatt fails to disclose each element of the claimed inventions. Consider claim 1, which includes a “system for updating merchant on file payment data at a payment processor comprising: a merchant processing selection system receiving selection data for one of two or more types of on file payment data update processing; and a merchant account update system receiving the selection data and processing account update data based on the selection data.” The Examiner cited to col. 4, lines 25-45 and col. 3 Myatt as allegedly disclosing these elements, but instead Myatt discloses a payment and authorization system. Nothing in the cited materials discloses a merchant processing selection system receiving selection data for one of two or more types of on file payment data update processing, although it is difficult to determine what, exactly, the Examiner considers to disclose this element, given the large amount of material cited. However, at a minimum, the terms “selection,” “on file,” “payment data,” “data update” and “payment data update” are not even used anywhere in Myatt, so it is difficult to understand how Myatt could allegedly disclose this limitation. The same is true for a merchant account update system receiving the selection data and processing account update data based on the selection data, as Myatt does not even disclose the terms “merchant account” or “update system.” Withdrawal of the rejection of claim 1 is respectfully requested.

Claim 2 includes the “system of claim 1 further comprising a database extraction system receiving the selection data and extracting account update records from merchant transaction records stored at a transaction processing system.” The Examiner cites to col. 4, lines 28-42 and col. 5, lines 64-68 of Myatt, and it is instructive to consider col. 5, lines 64-68, which state in their entirety: “Means are provided for quickly and repeatedly updating or revising the data in the negative file 30 and the authorization file 39. Such information may be, for example, updated daily to provide a current listing of negative file data.” While this section is not relevant to the claimed limitation, this section makes it clear that Myatt only discloses a single process for updating or revising the data in the negative file 30 and the authorization file 39. As such, it is clear that there is no selection data disclosed in Myatt for anything, much less relating to the claimed invention. Withdrawal of the rejection of claim 2 is respectfully requested.

Claim 4 includes the “system of claim 1 further comprising a merchant upload system receiving account update data from one or more card processor systems and converting the account update data based on a merchant record format.” The Examiner cites to col. 5, lines 35-68 as allegedly disclosing this limitation, but it is not possible to determine what, exactly, the Examiner is asserting discloses this claim in the large amount of material cited. Applicants note that the terms “merchant record,” “record format” and “merchant record format” are not disclosed anywhere in Myatt, so it is difficult to understand how Myatt could allegedly disclose this claim. Withdrawal of the rejection of claim 4 is respectfully requested.

Myatt in view of Rajaram fail to provide a prima facie basis for the rejection of claims 3 and 5-20 under 35 U.S.C. 103(a), as they fail to disclose each element of the claimed inventions. Consider claim 3, which includes the “system of claim 1 further comprising a merchant download system receiving the selection data and extracting account update records from a merchant batch file received at a transaction processing system.” The Examiner admits that Myatt fails to disclose a “download system receiving the selection data and extracting account update records from a merchant batch file received at a transaction processing system,” but asserts that limitation is disclosed somewhere in Rajaram, although no specific citation of where that limitation is allegedly disclosed in Rajaram is provided. Applicants note that the terms “merchant download,” “selection,” “selection data,” “batch,” and “merchant batch file” are not even used anywhere in Rajaram, so it is difficult to understand how Rajaram could allegedly disclose this claim. Withdrawal of the rejection of claim 3 is respectfully requested.

Claim 5 includes the system of claim 1 further comprising a card processor rules system applying one or more card processor rules to the account update data. Claim 6 includes the system of claim 1 further comprising an updater format system converting the account update data from a merchant format to a card processor system format. Claim 7 includes the system of claim 1 further comprising a record submission system submitting the account update data to one of two or more card processor systems using procedures specific to each card processor system. Claim 8 includes the system of claim 1 further comprising a card processor account update system receiving card processor rules and card processor format data from each of two or more card processor systems and applying the card processor rules and the card processor format data to the account update data prior to submission of the account update data to each card processor system. Claim 9 includes the system of claim 1 further comprising a merchant account update system receiving merchant format data from each of two or more merchant systems and converting account update response data received from each of two or more card processor systems for each merchant system using the merchant format data for each merchant system. Claim 10 includes the system of claim 1 further comprising an opt-out system receiving opt-out data from a card holder and extracting an account update record for that card holder from the account update data. While the Examiner does cite to various sections of both Myatt and Rajaram as allegedly disclosing these claims, it is difficult to understand the basis for the rejection. If both Myatt and Rajaram disclose the claim in question, such as is alleged for claims 5 and 8, then why are those claims rejected under 35 U.S.C. 103(a) and not 35 U.S.C. 102(b)? In regards to claim 7, is the citation to Rajaram or Myatt? In any event, Applicants note that many of the terms in these claims are not even used in either Myatt or Rajaram, such as “rule” (claims 5 and 8), “convert” (claim 6), “submission” (claim 7), “format” (claim 9), and “opt-out” (claim 10). As such, it is difficult to understand how either Myatt or Rajaram could allegedly disclose these claims. Withdrawal of the rejection of claims 5-10 is respectfully requested.

In regards to the rejection of claim 11, the Examiner admits that Myatt fails to disclose extracting update records at the payment processor if an extraction update type selection is received from the merchant; and formatting the extracted update records based on format rules for each of two or more card processing systems,” but asserts that these limitations can be found somewhere at col. 4-5 of Rajaram. This admission raises the question of how Myatt could possibly disclose the inventions of claims 1, 2 and 4 given that it fails to disclose these elements,

which are not identical to claims 1, 2 or 4, but which nonetheless certainly creates additional ambiguity in the Examiner's rejection of those claims. Furthermore, as Rajaram does not even use the term "update" anywhere within the four corners of that reference, it is difficult to understand how Rajaram can disclose these steps. Applicants also note that to anticipate a method claim under 35 U.S.C. 103, the cited references must disclose the method steps in the order required by the claims. *E-Pas s v. 3COM Corp.*, 473 F.3d 1213, 1222 (Fed. Cir. 2007) ("Substantively, because the language of most of the steps of its method claim refer to the completed results of the prior step, E-Pass must show that all of those steps were performed in order.) It is impossible to understand from the Examiner's cursory citations how Myatt in view of Rajaram can possibly anticipate claim 11. Withdrawal of the rejection of claim 11 is respectfully requested.

Claim 12 includes the "method of claim 11 wherein extracting the update records at the payment processor if the extraction update type selection is received from the merchant comprises: determining whether an update record has been previously submitted; extracting the previously submitted update record from an update file if a response code for the previously submitted update record bars resubmission of the update record." While the Examiner cites to col. 4, lines 1-42 and col. 6, lines 35-55 of Rajaram as allegedly disclosing this claim, nothing in the cited materials appears to be remotely related to this claim, and as previously noted, Rajaram does not even use the term "update." Withdrawal of the rejection of claim 12 is respectfully requested.

Claim 13 includes the "method of claim 11 further comprising: receiving a merchant update request file if a batch update type selection is received from the merchant; and formatting the merchant update request file based on format rules for each of two or more card processing systems." While the Examiner cites to col. 4, lines 1-42 and col. 6, lines 35-55 of Rajaram as allegedly disclosing this claim, nothing in the cited materials appears to be remotely related to this claim, and as previously noted, Rajaram does not even use the term "update." Withdrawal of the rejection of claim 13 is respectfully requested.

Claim 14 includes the "method of claim 11 further comprising applying one or more card processor rules for one or more of the card processing systems to the extracted update records." While the Examiner cites to col. 3, lines 35-50 of Rajaram as allegedly disclosing this claim, nothing in the cited materials appears to be remotely related to this claim, and as previously

noted, Rajaram does not even use the term “update,” nor does it use the term “rule.” Withdrawal of the rejection of claim 14 is respectfully requested.

Claim 15 includes the “method of claim 11 wherein extracting the update records at the payment processor if the extraction update type selection is received from the merchant comprises: determining whether an update record is for a restricted merchant category for one or more of the card processing systems; and removing the update record associated with the restricted merchant category code from an update file.” While the Examiner cites to the rejection of claim 11 (?), as previously discussed, nothing in the cited materials appears to be remotely related to this claim or claim 11, and as previously noted, Rajaram does not even use the term “update.” Withdrawal of the rejection of claim 15 is respectfully requested.

Claim 16 includes a “method for updating merchant on file payment data at a payment processor comprising: requesting an update type selection from a merchant; extracting update records at the payment processor if an extraction update type selection is received from the merchant; and receiving update records from the merchant if a batch update type selection is received from the merchant.” The Examiner’s rejection of claim 16 tracks the rejection of claim 11, even though these claims are of different scope. Again, it is difficult to understand how Myatt in view of Rajaram can possibly anticipate claim 16, as there are many key terms from the claims missing in both references, and the two references appear to disclose different processes that are entirely unrelated such that the references cannot possibly disclose the claimed method steps in the order required by the claim. Withdrawal of the rejection of claim 16 is respectfully requested.

As to claims 17 through 20, the same problems noted above also apply. The Examiner cites to vast sections of Myatt and Rajaram that do not even disclose key terms from the claims, do not appear to disclose anything remotely related to the claimed method steps, and which appear to disclose unrelated processes that can’t possibly disclose the claimed method steps in the order required by the claims. Withdrawal of the rejection of claims 17 through 20 is respectfully requested.

New claim 21 is presented in means plus function format so as to invoke the provisions of 35 U.S.C. 112(6). Controlling Federal Circuit precedent requires in “a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, *the disclosed structure is not the general purpose computer, but rather the*

special purpose computer programmed to perform the disclosed algorithm.” WMS Gaming, Inc. v. Int’l Game Technology, 184 F.3d 1339, 1349 (Fed. Cir. 1999). (Emphasis added.) Further recent guidance from the Federal Circuit confirms that flowchart algorithms and other data structures are the proper structure for means plus function claims drawn to special purpose computers. In *Allvoice Computing v. Nuance Comm.*, 504 F.3d 1236, 1245 (Fed. Cir. 2007), flowchart algorithms such as those in Figures 4 and 5 of the pending application were held to provide sufficient structure for such means plus function limitations. Applicants believe that neither Myatt nor Rajaram disclose the claimed structure or an equivalent thereof, and request that the Examiner specifically identify any such structure if it is alleged to exist so as to avoid the need to appeal any subsequent rejection of the claims.

CONCLUSION

In view of the foregoing remarks and for various other reasons readily apparent, Applicants submit that all of the claims now present are allowable, and withdrawal of the rejection and a Notice of Allowance are courteously solicited.

If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the Examiner is hereby requested by the undersigned at (214) 953-5990 so that such issues may be resolved as expeditiously as possible.

A fee for one additional dependent claim is believed due with this response. However, the Commissioner is hereby authorized to charge any fee or credit any refund to the Deposit Account No. 10-0096.

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Respectfully submitted,

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